

## REMARKS/ARGUMENTS

### Summary of Arguments

The applicant requests reconsideration of this rejection for the following reasons:

- (1) There is no justification, in Douglis and Flockhart, or in any other prior art separate from the applicant's disclosure that suggests that these references be combined, much less combined in the manner proposed.
- (2) Even if Douglis and Flockhart were to be combined in the manner proposed, the proposed combination would not show the new and unexpected results of claims 1-24, as amended, which are unobvious and patentable over these references.

### **PRIMARY ARGUMENT: Douglis And Flockhart Do Not Contain Any Justification To Support Their Combination, Much Less in the Manner Proposed.**

With regard to the proposed combination of Douglis and Flockhart, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art U.S.C. 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. For example, as was stated in Re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the

right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself....*Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied].

In line with these decisions, the Board stated more recently in Ex parte Levengood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the, applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual ‘to combine the relevant teachings of the references.’ ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”

In the present Office action, there is no reason given to support the proposed combination, other than the unsubstantiated statement below, (which in its first sentence, recognizes the novelty of the present invention):

However, Dougliš does not explicitly disclose establishing a standard duration from said first and said second communication. Thus, the artisan would have been motivated to look into the related networking management arts for potential methods and apparatus for implementing the establishment of standard duration from said first and said second communications. ... Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Flockhart's teachings of the defined duration with the teachings of Dougliš, for the purpose of *providing better achievement in efforts to create equal and reasonable workload and a predefined mix of call* [emphasis in original].

The foregoing statement provides no rationale or factual basis for the "motivating force" of Ex Parte Levensgood, apart from the fact that the suggested combination of prior art lacks a central feature of the invention. Applicant therefore submits that combining Dougliš and Flockhart is not legally justified and is therefore improper. Thus, applicant submits that the rejection on those references is also improper and should be withdrawn.

In addition, the Office action makes a strained interpretation of the references individually and in combination to show any similarities to the invention. For example, Dougliš measures time as the actual cost of the electronic communication, not of the persons ("users" of claim 7) involved in communicating, which would be apparent only from a comparison to business data (claim 8). Each of Dougliš and Flockhart is individually complete and functional in itself so there would be no reason to use parts from or add or substitute parts to either reference.

As cited in claim 1, and hence as per *In re Wright*, 6 USPQ 2d 1959 (1988), the invention solves a different problem from either of the references: determining the productivity of the communicating entities. Dougliš is not concerned with productivity of

the hosts (and has no mention of it), while Flockhart is concerned only with the productivity of the recipients of communications, the call-center agents, not with those originating the communications to them. Moreover, each of the two references solves different problems and falls into a different field from the other, so it would be illogical to combine them in the manner suggested in any way that makes sense or that meets the claims of the invention. Perhaps for that reason, the Office action does not explain how to combine them. The U.S. classification of Dougli is 709 (networked computer data processing); that of Flockhart 379 (telephonic communications). The Flockhart patent does not even include 709 in its prior-art field of search, while Dougli's single mention of having searched classification 379's subclass of 93.12 does not overlap with any of the classifications for Flockhart. Hence, the two patents themselves show it to be far from obvious that one skilled in the art would make any connection between the two. Neither prior art nor the Office action teaches what modifications would be necessary to combine the two references, or if in fact the combination is possible, without an awkward series of steps that are too involved as to be obvious.

Applicant, therefore, respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. Sec. 706.02(j), Ex parte Clapp, 227 U.S.P.Q.2d 972, 973 (P.O.B.A. 1985), and Ex parte Levengood, supra, "a "factual basis to support his conclusion that it would have been obvious" to make the combination.

**SECONDARY ARGUMENT: Even If Dougli and Flockhart Were To Be Combined In The Manner Proposed, the Novel Physical Features Of Claims 1-24,**

**As Amended, Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References Under 35 U.S.C. 103(a).**

The novel physical features of the present invention described in claims 1-24, as amended, produce new and unexpected results: the directional tracking of electronic communication traffic within and among organizations to provide normalized, time-based aggregates and graphic images showing patterns of communication and the time-based expense consumed by such electronic interactions of individuals and of organizations.

The process of computing a standard duration provides a new use for existing electronic communications themselves (and specifically, their metadata), rather than for the processes involved in handling such communications (as shown in Douglass or Flockhart).

These results are unobvious and patentable. Furthermore, the invention solves a previously unrecognized problem—and one neither mentioned nor implemented in the prior (and crowded) arts of telephonic communication and networked computer data processing: the need to understand and measure—through standardized time-based comparisons—the patterns of communication within and among organizations so as to improve productivity. Conversely, the invention solves—in a concrete, scientific fashion—a long-felt need to better manage one's time by highlighting and thence eliminating unnecessary or unwanted communication.

The invention also uses a new principle of operation—the creation of a standard duration from text-based communication records like e-mail to enable the aggregation of “apples”—time-based voice and video—with “oranges”—text-based e-mail and static images. The ability to do so presents the new and unexpected results of normalizing different types of electronic communication for determining productivity.

**The Rejection Of Claim 1 On DougliS And Flockhart Is Overcome.**

Neither DougliS nor Flockhart refer to the direction of a communication, which is a central component of independent claim 1, and from which the new and surprising results of tracking communication patterns derive. The connection, cited in DougliS (col. 2, line 16 – col. 3, line 35) does not specifically mention the direction of communication.

Despite the Office action's citation of DougliS (col. 2, line 63 – col. 3, line 35), DougliS has no mention of duration—by either word or by concept, nor of storing said duration (despite the citation of col. 4, line 42 – col. 5, line 2), while Flockhart uses the word “duration” only twice, and in passing, to refer to rest periods, not the length of a communication.

The Office action admits that DougliS does not determine a standard duration. Two elements: (1) the specific measurement of the duration of a communication—not the period between communications (alluded to by Flockhart as rest periods)—and (2) the establishment of a standard duration for comparison and to determine productivity are the essence of claim 1. These are missing from the two references: unlike the present invention's claim 1, for example, Flockhart (col. 8, lines 35-47, as cited) does not derive the productivity of communicating entities from the notion of a standard duration of communication. If anything, the causality flows in the opposite direction and bases variable periods of rest on prevailing workloads (col. 7, lines 9-64, as cited).

Since dependent claims 2 through 16 each incorporate all the limitations of the parent claim, the following dependent claims are each patentable for the same reasons given above, with respect to the parent claim. Furthermore, each dependent claim is even

less obvious in achieving new and surprising results because it adds additional limitations, briefly highlighted below.

**The Rejection Of Claim 2 On Douglass And Flockhart Is Overcome.**

Unlike the cited Fig. 4 of Douglass or Flockhart, col. 3, lines 27-39, the novel features of claim 2 in the present invention produce the new and unexpected result of graphically presenting the direction of a standardized duration of communication.

**The Rejection Of Claim 3 On Douglass And Flockhart Is Overcome.**

Unlike Douglass, col. 3, lines 12-36, as cited, the novel features of claim 3 in the present invention produce the new and unexpected result of receiving user-defined standards and alerting the user when a communication for a given direction, based on a standardized measure of duration violates one of any pre-determined standards.

**The Rejection Of Claim 4 On Douglass And Flockhart Is Overcome.**

Unlike Flockhart, col. 6, lines 48 – col. 7, line 64, as cited, the novel features of claim 4 in the present invention produce the new and unexpected result of reading (ie determining) from a received communication's metadata its measure of standard duration. Neither Flockhart nor Douglass makes any mention of a communication's metadata, much less of reading it.

**The Rejection Of Claim 5 On Douglass And Flockhart Is Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64, as cited, the novel features of claim 5 in the present invention produce the new and unexpected result of determining and storing the subject matter of the communication. As made clear in the text of the prior-art patent, Flockhart uses the term “work item” of Fig. 3 to refer, for example, to a call, not to its subject matter. Neither Flockhart nor Dougliis has any mention of a communication’s subject matter.

**The Rejection Of Claim 6 On Dougliis And Flockhart Is Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64, as cited, the novel features of claim 6 in the present invention produce the new and unexpected result of reading the subject matter from a communication’s metadata. As made clear in the text of the prior-art patent, Flockhart uses the term “work item” of Fig. 3 to refer, for example, to a call, not to its subject matter. Neither Flockhart nor Dougliis has any mention of a communication’s subject matter, a communication’s metadata—nor, therefore, of reading subject matter from metadata.

**The Rejection Of Claim 7 On Dougliis And Flockhart Is Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64, as cited, the novel features of claim 7 in the present invention produce the new and unexpected result of determining the time applied by a user to a particular subject matter and ranking the user according to that time. As made clear in the text of the prior-art patent, Flockhart’s use of the term “range” in Fig. 3 does not create a user-specific rank and particularly does not do so with regard to any subject matter. Neither Flockhart nor Dougliis has any mention



of a communication's subject matter, nor of deriving a ranking based upon time applied to a particular subject.

**The Rejection Of Claim 8 On DougliS And Flockhart Is Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64; col. 7, lines 47-59; col. 10, lines 61-67, as cited, the novel features of claim 8 in the present invention produce the new and unexpected result of associating the user-specific ranking by time spent on particular subject matters with business data. Neither Flockhart nor DougliS has any mention of a communication's subject matter, of deriving a ranking based upon time applied to a particular subject, nor of associating said ranking with business data.

**The Rejections Of Claims 9, 10, and 11 On DougliS And Flockhart Are Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64; col. 7, lines 47-59; col. 10, lines 61-67, as cited, the novel features of the present invention's claims 9, 10, and 11 (as currently amended to replace an earlier typo of "10" with "1") produce the new and unexpected results of establishing a standard duration for telephone calls, for e-mails, and for video data so as to determine productivity of the communicating entities. Flockhart determines durations for rest periods of call agents, not for the electronic communications of telephone calls, of e-mails, and of video data, themselves.

**The Rejection Of Claims 12 and 13 On DougliS And Flockhart Are Overcome.**

Unlike Flockhart, Fig. 3 and col. 6, line 48 – col. 7, line 64; col. 7, lines 47-59; col. 9, line 50 – col. 10, line 14; 55; col. 10, lines 61-67, as cited, the present invention's novel features of claims 12 and 13 (as currently amended for a missing hyphen) produce

the new and unexpected results of establishing a standard duration for transferred data files and for transferred data files, comprising mixed-media data.

**The Rejection Of Claims 14 and 15 On DougliS And Flockhart Are Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64; col. 7, lines 47-59; col. 10, lines 61-67, as cited, the novel features of claims 14 and 15 in the present invention produce the new and unexpected results of establishing a standard duration for instant messaging and for image files. Flockhart has no mention of image files, and neither Flockart nor DougliS mention instant messaging.

**The Rejection Of Claim 16 On DougliS And Flockhart Is Overcome.**

Unlike Flockhart, Fig. 3; col. 6, line 48 – col. 7, line 64; col. 7, lines 47-59; col. 10, lines 61-67, as cited, the novel features of claim 16 in the present invention produce the new and unexpected results of using the size and data format of the electronic communication to establish its standardized duration. Neither Flockhart nor DougliS mentions using a communication's size and data format for such a purpose.

**The Rejection Of Claim 17 On DougliS And Flockhart Is Overcome.**

As noted in the Office action, claim 17 (as amended to substitute "entity" for "user") is the corresponding system claim of claim 1; therefore, it produces new and surprising results under the same rationale as in claim 1 and hence is patentable.

**The Rejection Of Claims 18-24 On Douglass And Flockhart Are Overcome.**

As alluded to in the Office action, claims 18-24 are corresponding system claims of claims 2-8; therefore, they produce new and surprising results under the same rationale as claims 2-8 and hence are patentable.

**Cited References C-G Of Form PTO-892 And References Of Pages 1 And 2 Of Form PTO-1449 Do Not Teach Applicant's Invention Or Render It Obvious.**

Applicant has reviewed the remaining references cited by Examiner in addition to Douglass and Flockhart as well as those provided in the applicant's information disclosure of December 5, 2000. None of the references show applicant's invention or render it obvious.

**Conclusion**

For all the reasons given above, applicant respectfully submits that the claims 1-24, as amended, are of patentable merit under Section 103(a) because of all the new and surprising results that these claims provide. Accordingly, applicant submits that this application is now in full condition for allowance, which action applicant respectfully solicits.

**Conditional Request For Constructive Assistance**

The applicant has reviewed the claims of this application to be non-obvious and patentable over the prior art. If, for any reason this application is not believed to be in full condition for allowance, the applicant respectfully requests the constructive assistance

and suggestions of the Examiner pursuant to M.P.E.P. 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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Date: May 3, 2004

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\* Please note that, as of May 15, 2004, the applicant's contact information for correspondence will change, and as of that date, the U.S. Postal Service will no longer continue forwarding mail addressed to the previous address. The new address for all future correspondence with the applicant is as follows:

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May 5, 2004

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